

REMARKS

I. General

Claims 9-11, 14-29, 31-34 and 36-43 are pending in the application. Claims 9-11, 14-29, 31-34 and 36-43 have been rejected. Claims 44-45 are new. Applicant respectfully traverses the rejections of record and requests reconsideration in light of the remarks herein.

II. Claim Amendments

Claims 9 and 42 are amended and claims 44-45 are new. Support for the claims can be found at least in figure 2A and paragraphs [0003], [0028], [0039], [0046] and [0047] of the originally filed application. No new matter is added.

III. 35 U.S.C. § 103 Rejection

The test for non-obvious subject matter is whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would have been obvious to a person having ordinary skill in the art. The United States Supreme Court in *Graham v. John Deere and Co.*, 383 U.S. 1 (1966) set forth the factual inquiries which must be considered in applying the statutory test: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art. As discussed further hereafter, Applicant respectfully asserts that the claims include non-obvious differences over the cited references. Thus, the rejections should be withdrawn because when considering the scope and content of the applied references there are significant differences between the applied combination and rejected claims, as the applied combination fails to disclose all elements of the rejected claims.

A. Claims 9-11, 14-23, 42 and 43 rejections

Claims 9-11, 14-23, 42 and 43 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ogg et al., United States publication number 2002/0073039 (hereinafter *Ogg*) in view of Allport et al., United States publication number 2001/0037320 (hereinafter *Allport*) and in further view of Beaudoin et al., United States patent number 5,836,617 (hereinafter *Beaudoin*). Applicant traverses the rejection.

1. Independent claims 9 and 42

Claim 42 requires “affixing the machine generated postage stamp to the mail pieces to provide mail pieces processed by the high speed mail item computer processing system that have the appearance of a mail piece comprising a postage stamp that was obtained from a delivery service and was applied by hand, wherein the machine generated postage stamp is two separate labels appearing to be two different postage stamps which display postage amounts in increments that are offered by the delivery service and the two postage amounts displayed by the two separate labels total at least the determined postage amount” The *Final Action* cites *Ogg* in view of *Beaudoin* as teaching the claim; however, *Ogg* in view of *Beaudoin* do not teach the limitations. Rather, the references merely affix a single label per mail piece; moreover, the labels are do not display postage amounts in the claimed increments. As such, the cited references fail to teach the claim.

Claim 9 recites “said mail pieces have an appearance of a mail item comprising a traditional postage stamp that was obtained from a delivery service and was applied by hand, wherein said appearance of said mail item comprising a traditional postage stamp that was obtained from a delivery service and was applied by hand is achieved at least in part by said valid postage labels being formatted as said traditional postage stamp.” Claim 42 recites “mail pieces processed by the high speed mail item computer processing system that have the appearance of a mail piece comprising a postage stamp that was obtained from a delivery service and was applied by hand” The *Final Action* relies on *Ogg* in view of *Beaudoin* as teaching the claim; however, *Ogg* in view of *Beaudoin* do not teach the quoted limitations.

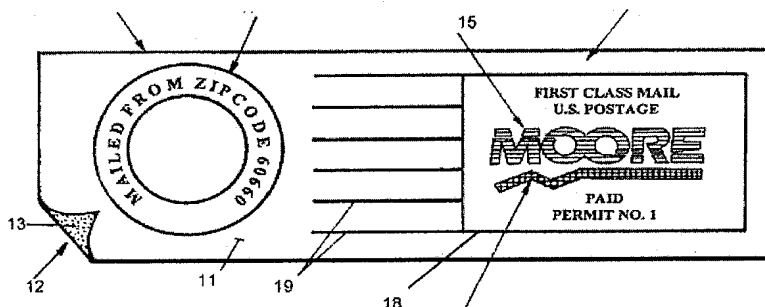


FIG. 1 of *Beaudoin*

The mail pieces taught by *Beaudoin* do not have the appearance of a mail item comprising a postage stamp that was obtained from a delivery service and was applied by hand because the labels disclosed by *Beaudoin* have tale-tale signs of traditional permit mail which make it obvious to one of ordinary skill that the label is a bulk permit label. Consider figure 1 from *Beaudoin*, which displays a permit number "PERMIT NO. 1." As is obvious from a visual inspection, a mail piece baring the label of *Beaudoin* does not have the appearance of a mail item comprising a traditional postage stamp because permit mail must include a permit number (as figure 1 does) while traditional postage stamps have no permit number. Moreover, the label indicates the zip code from which the label **must** be mailed from, which is another tale-tale sign of permit mail. Further, figure 1 does not display a postage amount, which is yet another indication to one of ordinary skill that the label is permit mail rather than a traditional postage stamp.

Likewise, consider the other figures disclosed by *Beaudoin* shown below (Figs. 2-5).

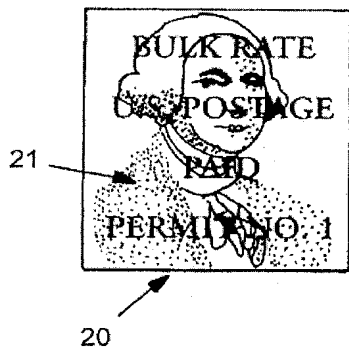


FIG. 2 of *Beaudoin*

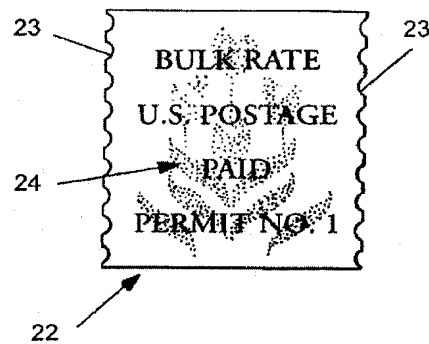
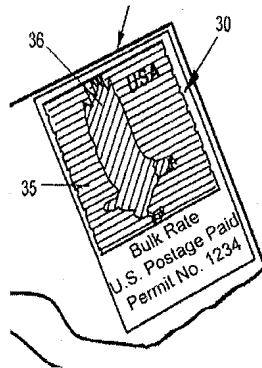
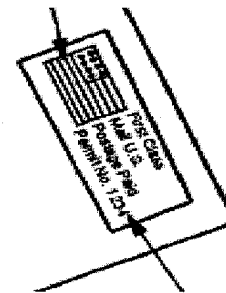


FIG. 3 of *Beaudoin*

FIG. 4 of *Beaudoin*FIG. 5 of *Beaudoin*

As can be seen, none of the labels in the figures appear to be a traditional postage stamp. Figures 2, 3, and 4 each expressly state the label is “BULK” indicia, which is a clear indication to one of ordinary skill that the label is not a traditional postage stamp. Furthermore, figures 2-5 of *Beaudoin* display permit information, (i.e. “PERMIT NO. 1,” “Permit No. 1234”), which makes the label obviously permit mail. Moreover, none of the figures include a numerical postage amount, which is yet another clear indication to one of skill that the label is not a traditional postage stamp. As such, *Beaudoin*’s disclosed labels are undoubtedly permit mail, and a mail item bearing the label would not be “mail pieces have an appearance of a mail item comprising a postage stamp that was obtained from a delivery service and was applied by hand.”

Moreover, the specific portions of *Beaudoin* cited by the *Final Action* do not cure the deficiencies. Column 4, lines 4-14 of *Beaudoin*, explains that its disclosed labels could be the height and width of a conventional postage stamp (e.g. 1 inch by 7/8 inches). However, even if the labels of *Beaudoin* were so dimensioned, the label would still obviously be a permit indicium. Consider figures 2-5. Even if the labels were 1 inch by 7/8 inches, the labels would still bare the tale-tale signs of permit mail because the label would state that it was bulk processed, have no numerical postage amount, and display a permit number.

Further, column 5, lines 25-39 discloses the labels may be conventional labels which have a release sheet carrier. However, even if *Beaudoin*’s taught labels were printed on a conventional label with a release sheet carrier, the labels would still obviously be permit mail. Consider figures 2-5. Even if the labels were printed on a conventional label with a release

sheet carrier, the labels would still bare the tale-tale signs of permit mail because the label would state that it was bulk processed, have no numerical postage amount, and display a permit number.

As such, *Beaudoin* does not teach “mail pieces have an appearance of a mail item comprising a traditional postage stamp that was obtained from a delivery service and was applied by hand, wherein said appearance of said mail item comprising a traditional postage stamp that was obtained from a delivery service and was applied by hand is achieved at least in part by said valid postage labels being formatted as said traditional postage stamp”, nor does the reference teach “mail pieces processed by the high speed mail item computer processing system that have the appearance of a mail piece comprising a postage stamp that was obtained from a delivery service and was applied by hand” Moreover, the additionally cited references fail to cure the deficiency. Thus, because each and every limitation of the claim is not taught or made obvious by the relied upon combination, Applicant requests the rejection of record be withdrawn and the claim be allowed.

2. Dependent claims 10-11, 14-23, and 43 rejections

Dependent claims 10-11, 14-23, and 43 are rejected as being obvious; however, each of the dependent claims depend from independent claims 9 and 42, respectively. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” MPEP 2143.03. As shown above, the independent claims are nonobvious in light of the relied upon combination. Thus, the dependent claims are likewise nonobvious. Accordingly, Applicant requests the rejections of record be withdrawn and the claims be allowed.

3. Claims 24-29, 33, 34 and 36-40 rejections

Claims 24-29, 33, 34 and 36-40 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Ogg* in view of *DeWitt et al.*, United States publication number 2003/0014376 (hereinafter *DeWitt*) in further view of *Beaudoin*. Applicant traverses the rejections.

4. Independent claim 24

Claim 24 requires “said associated mail pieces have an appearance of a mail item comprising a postage stamp that was obtained from a delivery service and was applied by hand” The *Final Action* admits that *Ogg* and *DeWitt* fail to disclose the limitation and relies on column 4, lines 4-14 of *Beaudoin* instead. *Final Action* at 14. However, as explained above regarding claims 9 and 42, *Beaudoin* fails to teach the limitation. Moreover, the additionally cited references fail to cure the deficiencies detailed above. As such, the references fail to teach or make obvious the claim, and Applicant requests the rejection of record be withdrawn.

5. Dependent claims 25-29, 33, 34 and 36-40

Dependent claims 25-29, 33, 34 and 36-40 are rejected as being obvious; however, each of the dependent claims depend from independent claim 24. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” MPEP 2143.03. As shown above, the independent claim is nonobvious in light of the relied upon combination. Thus, the dependent claims are likewise nonobvious. Accordingly, Applicant requests the rejections of record be withdrawn and the claims be allowed.

IV. New Claims

Claims 44-45 are new. Claim 44 requires “wherein no human readable portions of said valid postage labels display permit information and wherein the valid postage labels display a postage amount in an increment that is available from the delivery service.” Claim 45 requires “wherein no human readable portions of said valid postage labels display permit information.” As explained above regarding claims 9 and 42, the cited references the taught labels bare the tale-tale signs of metered mail because the labels state that it was bulk processed, have no numerical postage amount, and display a permit number. As such, claims 44-45 are in condition for allowance.

Moreover, dependent claims 44-45 depend from independent claims 24 and 42, respectively. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988)." MPEP 2143.03. As shown above, the independents claim are nonobvious in light of the relied upon combination. Thus, the dependent claims are likewise nonobvious. Accordingly, Applicant requests the claims be allowed.

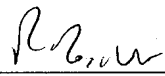
V. Conclusion

In view of the above, applicant believes the pending application is in condition for allowance.

Applicant believes an RCE fee of \$405.00 is due with this response. This fee will be paid on-line by credit card. Please charge any additional fees required or credit any overpayment during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees to Deposit Account No. 06-2380, under Order No. 61135/P022US/10303187 from which the undersigned is authorized to draw.

Dated: July 12, 2010

Respectfully submitted,

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